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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,846	06/15/2001	Steven W. Lundberg	1301.004US1	8778
21186	7590	01/09/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			OUELLETTE, JONATHAN P	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/882,846	Applicant(s) LUNDBERG, STEVEN W.	
	Examiner Jonathan Ouellette	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 47-52 have been added; therefore Claims 1-52 are now pending in application 09/882,846.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette et al. (US 5,991,751).**
4. As per **independent Claims 1 and 22**, Rivette discloses an Internet-based method (on-line system), comprising: a user entering into a client computer on the Internet one or more first criteria for a search of an IP database kept on a server computer system on the Internet and containing records of intellectual property assets owned by a plurality of different owners; searching the IP database for records matching the one or more criteria (C26 L7-23, Searching Module); displaying to the user on the client computer a list of records found in the search; allowing the user to optionally reject, using the client

computer, selected records in the list; adding non-rejected records to a user portfolio database (C26 L7-59, Grouping); the user adding additional records to the user portfolio database one at a time by identifying intellectual property assets one at a time using the client computer (C26 L17-23, Drag Drop); the user specifying, using the client computer, one or more additional search criteria for an IP database, the search criteria being the same as or different from the first criteria (C26 L7-59); the server computer system using the additional search criteria to automatically search the IP database on a recurring basis on at least some of the days following the original search; displaying to the user, on the client computer, a list of records found in the additional searches (C30 L41-59, Automatic Searching); allowing the user to optionally reject selected records in the list using the client computer (C26 L17-23, Drag Drop); and adding non-rejected records to the user portfolio database (C30 L41-59).

5. As per Claims 2 and 23, Rivette discloses automatically performing a watch service for at least one of the IP assets in the user portfolio (Group) (C88, Patent Aging Module; C93, Financial Module; C96-98).
6. As per Claims 3 and 24, Rivette discloses automatically performing a watch service on the server computer system for a plurality of different IP assets in the user portfolio and presenting watch results to a user with the client computer.
7. As per Claims 4 and 25, Rivette discloses keeping docketing information on the server computer system and presenting docketing information on the client computer for one or more of the IP assets in the user portfolio database.

8. As per Claims 5 and 26, Rivette discloses wherein the docketing information is renewal or maintenance or annuity docketing information.
9. As per Claims 6 and 27, Rivette discloses wherein the docketing information includes fees owed for an IP asset and the dates such fees are owed.
10. As per Claims 7 and 28, Rivette discloses wherein the docketing information concerns the renewal or maintenance of a trademark.
11. As per Claims 8 and 29, Rivette discloses displaying to a user docketing status information for one or more IP assets.
12. As per Claims 9 and 30, Rivette discloses collecting from a user on a client computer information required to perform a legal service with respect to an IP asset in a user portfolio database.
13. As per Claims 10 and 31, Rivette discloses wherein the required information is renewal or maintenance information for a trademark.
14. As per Claims 11 and 32, Rivette discloses wherein the required information pertains to maintenance of a patent.
15. As per Claims 12 and 33, Rivette discloses performing data analysis or processing regarding one or more IP assets in the user portfolio database (C34 L23-57, Analysis Module).
16. As per Claims 13 and 34, Rivette discloses a user ordering electronic or paper copies of documents pertaining to one or more of the IP assets in the user portfolio database (C96, Exporting Data).

17. As per Claims 14 and 35, Rivette discloses a user requesting on the client computer that electronic copies of documents pertaining to one or more IP assets in the user portfolio be made available for access by the user.
18. As per Claims 15 and 36, Rivette discloses displaying to the user on the client computer a user activated with one or more IP assets in the user portfolio database that allows the user to view an electronic image of a document associated with an IP asset in the user portfolio database.
19. As per Claims 16 and 37, Rivette discloses wherein the electronic copies are owned by the user and can be downloaded by the user.
20. As per Claims 17 and 38, Rivette discloses wherein the electronic copy is a PDF format copy.
21. As per Claims 18 and 39, Rivette discloses wherein the server computer system includes one or more computing or storage devices.
22. As per Claims 19 and 40, Rivette discloses wherein the computing devices and storage devices are located in different locations.
23. As per Claims 20 and 41, Rivette discloses wherein the client computer is a personal computer or a workstation computer or an Internet appliance.
24. As per Claim 21, Rivette discloses wherein the search criteria are owners or assignees of the IP assets.
25. As per Claim 42, Rivette discloses where a hypertext markup language is used to display information on a client computer (C37, Web).

26. As per Claim 43, Rivette discloses wherein the client computer is enabled to display information to a user in response to a hypertext markup language (C37, Web).
27. As per Claim 44, Rivette discloses wherein the server computer system sends programming information to the client computer using JAVA computer language instructions or commands (C37, Network).
28. As per Claim 45, Rivette discloses wherein the server computer system is enabled to send programming information to the client computer using JAVA computer language instruction or commands (C37, Network).
29. As per Claim 46, Rivette discloses a computer program embodied in a machine readable media comprising computer instruction that perform any one of the methods set forth in claims 1-21.
30. As per Claims 47 and 50, Rivette discloses wherein searching the IP database for records includes searching image files (C25 L50-56, C30 L37-40).
31. As per Claims 48 and 51, Rivette discloses pattern identification (C26 L29-33, graphical searching, likeness of images).
32. As per Claims 49 and 52, Rivette discloses image identification (C26 L29-33, graphical searching).

Response to Arguments

33. Applicant's arguments filed 10/28/2005, with respect to Claims 1-52, have been considered but are not persuasive, the rejection will remain as **FINAL** based on the cited prior art.

34. The Applicant makes the argument that the cited prior art fails to teach or suggest the user adding additional records to the user portfolio database one at a time by identifying intellectual property assets one at a time using the client computer.
35. However, Rivette teaches the ability of the user to separately select documents (records) and place them into a new or existing group (portfolio database), through a drag and drop process (C26 L17-23, Drag Drop).
36. The Applicant makes the argument that the cited prior art fails to teach or suggest maintaining/managing docketing information, to include: renewal, fees owed, maintenance, and status.
37. However, the purpose behind Rivette's system is to manage a vast amount of IP information - to include financial analysis of IP assets, which would necessarily include the storage of renewal, fees owed, maintenance, and status information or equivalent (C57, C93 L16-17).
38. Furthermore, Rivette describes systems used for the managing corporate patent prosecution and the payment of maintenance fees as prior art (C2, Fig.1), and Rivette's invention is meant to serve as an improvement on said systems.
39. The Applicant makes the argument that the cited prior art fails to teach or suggest performing legal services with respect to IP assets.
40. However, Claims 9-11 do not actually claim the performance of legal services, but rather, collecting information required to perform a legal service.
41. Rivette discloses collecting IP asset information that would be required if and when the user of Rivette's system wanted to perform legal services pertaining to the IP assets, as

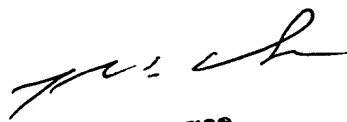
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can be seen by the summary of the system and description of the background prior art (Fig.1).

Conclusion

42. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
43. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
44. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.


jo
December 29, 2005


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600